



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/756,752

01/14/2004

Yoshihiro Seto

Q79385

1534

23373 7590 11/13/2008
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

HYUN, PAUL SANG HWA

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

11/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/756,752	Applicant(s) SETO ET AL.	
	Examiner PAUL S. HYUN	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/28/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment filed by Applicant on 8/27/08 has been acknowledged. Claims 1-8 remain pending. All pending claims have been amended.

The IDS filed by Applicant on 7/28/08 has been acknowledged.

The amended Drawing filed by Applicant identifying Figure 3 as "Prior Art" has been acknowledged. Consequently, the objection to the Drawings cited in the previous Office action has been withdrawn.

The claim rejections under 35 U.S.C. section 112 cited in the previous Office action have been withdrawn in light of the amendments.

Despite the amendments, the art rejections are maintained.

Claim Objections

Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form.

Claim 6 merely recites a method of loading a cartridge into the claimed invention. The claim does not further limit the structure of the claimed invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1797

Claims **3, 6 and 8** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "a sidewall with no cutout". There is insufficient antecedent basis for this limitation in the claim. Amending the claim from "the wall with no cutout" to "a wall with no cutout" did not rectify the indefiniteness issue because it is improper to define the scope of a claimed element with respect to another element without first establishing a precedence for the another element. Specifically, claim 3 should explicitly recite that the claimed invention comprises "a side wall with no cutout" before defining the heights of the posts with respect to "a side wall with no cutout".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1, 2, 4 and 5** are rejected under 35 U.S.C. 102(e) as being anticipated by Crowley (US 6,663,100 B2).

Crowley discloses a magazine 200 for storing a stack of articles (see Fig. 3). The magazine comprises an open top, sides 206 and 208 comprising cutouts 210 that extend to the top edges of said sides, and front and rear sides 202 and 204 comprising cutouts 212.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1, 2, 4, 5 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's own disclosure of prior art in view of Crowley (US 6,663,100 B2).

According to the Specification of the instant application, Figure 3 shows a conventional cartridge that is well known in the art. The cartridge is designed to store and dispense dry analysis test strips. The cartridge comprises a housing chamber 31 comprising an element charging port that is defined by the opening at the top of the

Art Unit: 1797

housing chamber, cutouts 32 and 33 formed in opposite walls of the housing chamber, a guide hole 35, and a take-out port through which the test strips are dispensed. The conventional cartridge differs from the claimed invention in that the conventional cartridge does not comprise cutouts on adjacent walls.

Crowley discloses a magazine 200 for storing a stack of articles (see Fig. 3). The magazine comprises an open top and sidewalls wherein each wall comprises cutouts. The reference discloses that the cutouts reduce friction when articles are loaded therein, and they allow the level and the condition of the stack to be easily viewed (see lines 23-28, col. 6). In light of the disclosure of Crowley, it would have been obvious to one of ordinary skill in the art to provide each wall of the conventional cartridge disclosed by Applicant with a cutout.

With respect to claim 7, since the front and the rear walls of the conventional cartridge comprise the take-out port and the guide hole, respectively, it would have been obvious to one of ordinary skill in the art not to form the cutouts as deep as the cutouts formed on the adjacent sidewalls.

Claims **3, 6 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's own disclosure of prior art in view of Crowley as applied to claims 1, 2, 4, 5 and 7 above, and further in view of Cunningham (US 5,127,207).

Neither Crowley's cartridge nor the conventional cartridge admitted to be prior art by Applicant comprises walls that differ in height. In addition, neither reference discloses cutouts on exactly three walls.

Art Unit: 1797

With respect to the height of the walls, Cunningham discloses a tray that is designed to receive articles therein (see Fig. 3). The tray comprises four posts 36-39 wherein the height of posts 37 and 39 are greater than the height of opposing posts 36 and 38. The reference discloses that the height difference is designed to ease the loading of articles therein. The article being loaded initially hits the taller posts, which facilitates the alignment of the article as it is being loaded (see lines 19-25, col. 4). In light of the disclosure of Cunningham, it would have been obvious to one of ordinary skill in the art to differ the height of the walls of the modified conventional cartridge.

With respect to the number of cutouts, it would have been obvious to one of ordinary skill in the art to form cutouts on exactly walls to optimize the balance between friction reduction and maintaining the structural integrity of the cartridge.

With respect to claim 8, since the front and the rear walls of the conventional cartridge comprise the take-out port and the guide hole, respectively, it would have been obvious to one of ordinary skill in the art not to form the cutouts as deep as the cutouts formed on the adjacent sidewalls.

Response to Arguments

Rejection of claims 1, 2, 4 and 5 as being anticipated by Crowley:

Applicant's argument with respect to the Crowley reference has been fully considered but it is not persuasive. Applicant argues that Crowley does not disclose the claimed cutouts. Rather, Applicant argues that Crowley discloses guides having spaces therebetween, and that the spaces do not constitute the claimed cutouts. This argument is not persuasive because a "cutout" is not tangible. The limitation "cutout" merely

Art Unit: 1797

denotes the absence of a tangible material. Therefore, any void space between two objects, regardless of how the void space is formed, is within the scope of a "cutout". In this case, Crowley discloses a plurality of void spaces 210 between guides 206 and 208 on every wall. For the foregoing reason, the rejection of claims 1, 2, 4 and 5 is maintained.

Rejection of claims 1, 2, 4, 5, and 7 as being unpatentable over Applicant's own disclosure in view of Crowley:

Applicant's argument that there is no motivation to combine the teachings of the admitted prior art and the Crowley reference has been fully considered but it is not persuasive. Specifically, Applicant argues that the admitted prior art is directed towards a cartridge for storing and dispensing a stack of biosensors whereas the disclosure of Crowley is directed towards a hopper for loading large stacks of paper. In short, Applicant argues that they are non-analogous art. This argument is not persuasive because the disclosure of both references is directed towards analogous art, which is a hopper for storing a stack of articles. In this case, the Crowley reference was relied upon for its disclosure that it is advantageous to provide cutouts in the walls to reduce friction when the articles are loaded into the hopper. The Examiner maintains the position that the motivation relied upon to modify the admitted prior art does not teach away from the admitted prior art or render the admitted prior art inoperable.

Applicant also argues that it is mere speculation that the admitted prior art suffers from friction. This argument is not persuasive. Given the nature of the admitted prior art and the disclosure of Crowley, the Examiner maintains the position that a *prima facie*

Art Unit: 1797

case has been established that reducing friction is sufficient motivation to modify the admitted prior art. As acknowledged by Applicant, because the hopper disclosed by Crowley is directed to loading large stacks of paper whereas the admitted prior art is concerned with precise and accurate loading and dispensing of biosensors, it is likely that the issue of friction is more prevalent for the hopper of the admitted prior art than the hopper disclosed by Crowley. To accurately and precisely load and dispense biosensors, the dimensions of the hopper must correspond closely to the dimensions of the biosensors. For the foregoing reason, the rejection of claims 1, 2, 4, 5 and 7 is maintained.

Rejection of claims 3, 6 and 8 as being unpatentable over Applicant's own disclosure in view of Crowley, and further in view of Cunningham:

Applicant's argument that there is no motivation to combine the teachings of Cunningham with teachings of the admitted prior art and the Crowley reference has been fully considered but it is not persuasive. It should be noted that the disclosure of Cunningham relied upon is limited to the difference in heights of posts that define the walls of a hopper. Cunningham discloses that the height difference is designed to ease the loading of articles therein by allowing the article to initially contact the taller posts, facilitating the alignment of the article as it is being loaded (see lines 19-25, col. 4). The Examiner maintains the position that this is sufficient motivation to combine the teachings of Cunningham with the teachings of the admitted prior art and Crowley. Applicant's citation of the passages of Cunningham directed towards roller bars and

Art Unit: 1797

vacuum suction was not relied upon, and it is not even relevant to the teaching relied upon. For the foregoing reason, the rejection of claims 3, 6 and 8 is maintained.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL S. HYUN whose telephone number is (571)272-8559. The examiner can normally be reached on Monday-Friday 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1797

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul S Hyun/
Examiner, Art Unit 1797

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797